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| 08/926,819      | 09/10/97    | TSENG M              | GC/7982ACIPC        |

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QM11/0324

EXAMINER  
DEXTER, C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3724     |              |

DATE MAILED: 03/24/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/926,819**

Applicant(s)  
**Tseng**

Examiner  
**Clark F. Dexter**

Group Art Unit  
**3724**



☒ Responsive to communication(s) filed on Dec 18, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 20-37 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 20-37 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of group I (claims 1-18) in the response filed December 18, 1998 (paper no. 5) is acknowledged. Claim 19 has been withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

2. Claims 29-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, lines 1-2, "wherein said skin engaging member comprises" is vague and appears to be redundant, and it is suggested to replace this phrase with --comprising-- or the like.

In claim 30, line 2, "adapted to change color" is vague and indefinite as to how the skin engaging member is "adapted", and further the limitation is vague and indefinite since there is not sufficient structure set forth to perform the claimed function. ←

In claim 31, line 3, the alternative recitation of "according to claim 27 or 30" renders the claim vague and indefinite as to structure of the skin engaging member.

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In claim 32, lines 11-12, the phrase "adapted to be immovably affixed to said razor cartridge and to erode" is vague and indefinite as to what is being set forth, particularly as to how the skin engaging layer is "adapted".

***Double Patenting***

3. Claims 20-37<sup>✓</sup> are provisionally rejected under the judicially created doctrine of non-statutory double patenting over the claims of U.S. application serial number 08/461,318.

Although the conflicting claims are not identical, they are directed to the same inventive concept and are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent specification and covered by the patented claims. The patented claims are inclusive for they are drafted using the "comprising-type" format and cover the subject matter of the application claim(s). Since applicant has obtained the right to exclude others from making and using the subject matter set forth in the claims of this application by virtue of the patented claims, the issuance of this application into a patent without a terminal disclaimer as provided for under 37 CFR § 1.321(b) would amount to an unjustified extension of this right.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27-37, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Castello.

Castello discloses a layered member, particularly beginning at the bottom of column 3, with every structural limitation of the claimed invention including two, disparately colored, solid polymeric layers.

***Claim Rejections - 35 USC § 102/103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27-31, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Creasy.

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Creasy discloses a skin engaging member (claims 27-30) and a razor cartridge (claim 31) with every structural limitation of the claimed invention including a skin engaging member (e.g., 22') affixed adjacent a blade (e.g., 20), wherein the skin engaging member comprises a water insoluble polymer, a shaving aid, and means for indicating a change in said amount of shaving aid (e.g., the wearing of the skin engaging member and the fading of the color of the skin engaging member).

In the alternative, if it is argued that Creasy does not disclose the skin engaging member being colored, the Examiner takes Official notice that such skin engaging members are old and well known in the art for various benefits including providing a pleasing aesthetic appearance. It is further known that such colored skin-engaging members fade during their lifetime due to use of the razor blade. Therefore, it would have been obvious to one having ordinary skill in the art to provide a colored skin engaging member for the well known benefits including that described above.

8. Claims 20-25 are rejected under 35 U.S.C. 102(b) as anticipated by Rogers et al. (pn 5,113,585) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rogers et al. in view of Althaus et al. (pn 5,134,775).

Rogers et al. discloses every structural limitation of the claimed invention.

In the alternative, if it is argued that Rogers et al. lacks core, Althaus et al. discloses (in the embodiment of Figures 5-6b) a core (e.g., 8) to store and dispense additional shaving aid agents. Therefore, it would have been obvious to one having ordinary skill in the art to provide a

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core in the skin engaging member of Rogers et al. for the benefits taught by Althaus et al. including that described above.

***Claim Rejections - 35 USC § 103***

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. in view of Althaus et al.

Rogers et al. lacks a disparately colored core. Althaus et al. discloses (in the embodiment of Figures 5-6b) a core (e.g., 8) to store and dispense additional shaving aid agents. Therefore, it would have been obvious to one having ordinary skill in the art to provide a core in the skin engaging member of Rogers et al. for the benefits taught by Althaus et al. including that described above. Further, to make the core a color different than the sheath would be a matter of design choice of materials since different materials provide different benefits and the color of these materials lacks criticality to the operation of the device as claimed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

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Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name and title.

**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
March 15, 1999